

Appln. Serial No. 09/706,960
Amendment Under 37 C.F.R. § 1.116
Reply to Office Action Mailed December 23, 2004

REMARKS

In the Office Action dated December 23, 2004, claims 1, 2, 4-7, 9-11, and 30-32 were rejected under 35 U.S.C. § 103 over U.S. Patent No. 5,713,024 (Halladay) in view of U.S. Patent No. 5,627,964 (Reynolds); claim 3 was rejected under § 103 over Halladay in view of Reynolds and "Introduction" from TCP/IP Illustrated, Volume 1 by W. Richard Stevens (Stevens); claim 8 was rejected under § 103 over Halladay in view of Reynolds and U.S. Patent No. 6,381,694 (Yen); claims 12-16 and 18-20 were rejected under § 103 over Halladay in view of Stevens; claim 24 was rejected under § 103 over Halladay in view of Stevens and U.S. Patent No. 4,972,316 (Dixon); claims 25 and 26 were rejected under § 103 over Halladay in view of Stevens and Reynolds; claims 28 and 33 were rejected under § 103 over Halladay in view of Dixon and Reynolds; and claim 29 was rejected under § 103 over Halladay in view of Dixon and Stevens.

Claims 12, 13, 15, 16, 18, 19, 24-26, and 29 have been cancelled, without prejudice, to render the rejection of the claims moot.

The amendments made herein have either cancelled claims or amended dependent claims into independent form without changing the scope of each claim so amended, and without affecting dependencies of other claims. Therefore, entry of the amendment is respectfully requested.

It is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to independent claim 1 over Halladay in view of Reynolds. To establish a *prima facie* case of obviousness, at least the following criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; and (2) the prior art references when combined must teach or suggest all the claim limitations. M.P.E.P. § 2143 (8th ed., Rev. 2), at 2100-129. Here, the Office Action has failed to establish either requirement of a *prima facie* case of obviousness.

As conceded by the Office Action, Halladay does not disclose a storage element containing a flag to indicate if a fault has occurred with a first operational element. 12/23/2004 Office Action at 4. However, the Office Action cited Reynolds as teaching such a storage element for storing a flag. The *prima facie* case of obviousness fails for the reason that there existed no motivation or suggestion to combine the teachings of Halladay and Reynolds.

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Halladay specifically teaches the use of a floppy disk that is specially formatted. Halladay, 7:57-8:19. According to Halladay, a user initiates a cold boot process by loading the cold boot floppy disk into the floppy drive of the computer system. Halladay, 8:22-28. This causes a cold boot application program to be loaded for execution for performing the restoring of data onto the hard drive. However, note that Halladay specifically teaches that a user must load the floppy disk to start the cold boot process. There is absolutely no need to store a special flag in Halladay, as loading the floppy disk itself is the act for starting the restoring process in Halladay.

In other words, there existed absolutely no suggestion of any desirability to incorporate, into Halladay, the storage of a special flag to indicate if a fault has occurred with a first operational element, in combination with using the special flag to cause a backup device to enable access of a network through an interface. It is well established law that "[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) (emphasis added). As the Federal Circuit has stated, "virtually all [inventions] are combinations of old elements." *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). "Most, if not all, inventions are combinations and mostly of old elements." *Id.*

Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'

Id.

In view of the fact that there existed absolutely no reason or need to incorporate a flag for indicating a fault in the Halladay system, it is respectfully submitted that the only basis for the assertion in the Office Action that it would have been obvious to use such a flag in the Halladay system is based on impermissible hindsight. Without the teachings of the disclosure of the present invention, a person of ordinary skill in the art looking to the teachings of Halladay would not have been motivated to incorporate a flag for indicating a fault, since Halladay requires that a

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user initiates the cold boot process described in Halladay by loading a specially formatted floppy disk. There would have been no reason whatsoever to use any type of flag for indicating if a fault has occurred, including the flag described in Reynolds, in the system of Halladay. Therefore, there existed no motivation or suggestion to combine Reynolds with Halladay in the manner proposed by the Office Action.

Moreover, a person of ordinary skill in the art looking to the teachings of Reynolds would not have been motivated to incorporate the fail-safe identifying flag of Reynolds into the system of Halladay. Reynolds is concerned about entering a fail-safe mode based on the special flag. Reynolds clearly is not concerned about restoring data from a backup device in response to this special flag. Instead, Reynolds teaches entry of a fail-safe mode in response to a failure, where a reduced set of graphical features are provided in fail-safe mode. Reynolds, 3:31-55. Thus, Reynolds provided no suggestion to modify the system of Halladay to start a backup process in response to a special flag to identify that a fault has occurred with an operational element. The foregoing establishes that no motivation or suggestion existed to combine the teachings of Halladay and Reynolds to achieve the claimed invention – therefore, a *prima facie* case of obviousness has not been established.

A further reason that a *prima facie* case of obviousness has not been established with respect to claim 1 is that even if Halladay and Reynolds can be properly combined, the hypothetical combination of the references does not teach or suggest each and every element of claim 1. Note that the flag recited in claim 1 is specific: it is a flag to indicate if a fault has occurred with the first operational element, *and* a backup device enables access of the network through the interface *in response to the flag indicating failure of the first operational element*. Thus, the flag cannot just be any flag that indicates that a fault has occurred – the flag has to indicate if a fault has occurred, *and* a backup device has to be responsive to *the flag* indicating failure to enable access of a network. Reynolds teaches a special flag that indicates whether fail-safe mode is to be established in response to a previous failure. Reynolds, 6:28-31. However, the special flag of Reynolds is *not* used to cause a backup device to enable access of a network. Rather, the special flag of Reynolds causes entry of the fail-safe mode where reduced graphical capabilities are available. Thus, even if Halladay and Reynolds can be properly combined, the hypothetical combination of Halladay and Reynolds does not teach or suggest all

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elements of claim 1. Therefore, a *prima facie* case of obviousness of claim 1 over Halladay and Reynolds has not been established for this additional reason.

Withdrawal of the obviousness rejection of claim 1 is respectfully requested. Claims dependent from claim 1 are allowable for at least the same reasons.

Moreover, with respect to claim 4, neither Halladay nor Reynolds teaches a backup routine comprising a browser that has been adapted to perform communications through a network stack including an IP layer. The Office Action cited a passage that starts in column 5, at line 3, of Halladay as teaching this browser. The passage refers to a user accessing cold boot data backup system 10 via a standard application program activation process native to a computer system. There is no indication whatsoever in this passage of a browser. A person of ordinary skill in the art would understand the term "browser" means the following: "short for Web browser, a software application used to locate and display Web pages." Wikipedia, definition for "browser" (attached). The "standard application program activation process native to computer system 1" referred to in the column 5 passage cited by the Office Action does not refer to a web browser. Therefore, because Halladay and Reynolds fails to disclose or suggest another express element of claim 4, it is respectfully submitted that the *prima facie* case of obviousness is defective for this additional reason.

Claim 14 has been amended from dependent from to independent form, with the scope of the claim remaining *unchanged*. Claim 14 was rejected as being obvious over Halladay and Stevens. Claim 14 recites that the backup software routine comprises a browser, where the browser is executed to access the network through a network stack including an IP layer to retrieve data comprising an image containing user data in an operating system. The Office Action cited to a passage starting in column 8, at line 45, of Halladay as teaching this feature of claim 14. This cited passage in Halladay refers to a cold boot application program that initiates a hard drive restore process and that instructs the user to load a backup media into a backup drive. However, there is no mention whatsoever in this passage of Halladay, or anywhere else in Halladay, or in the teachings of Stevens, of a browser that is executed to load data containing an image having user data in an operating system. As discussed above, the term "browser" refers to a "Web browser," which is a software application used to locate and display web pages. There is no teaching whatsoever of this feature in Halladay or Stevens.

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Therefore, because the hypothetical combination of Halladay and Stevens does not teach or suggest all elements of the claim, a *prima facie* case of obviousness has not been established with respect to claim 14 over Halladay and Stevens.

Claim 20 also has been amended from dependent form to independent form, with the scope of claim 20 remaining *unchanged*. Claim 20 recites the loading of a browser from a backup storage device to enable network communication through a network stack including IP layer for retrieving an image to recover a system, where the image comprises user data in an operating system. As discussed above with respect to claim 14, the hypothetical combination of Halladay and Stevens fails to disclose or suggest this subject matter. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 20 over Halladay and Stevens.

Claim 28 was rejected as being obvious over the asserted combination of Halladay, Dixon, and Reynolds. As conceded by the Office Action, Halladay and Dixon do not disclose the following elements of claim 28: setting a flag in response to a fault, loading a BIOS routine to detect whether the flag is set, and causing the BIOS routine to load a second routine in response to detecting the flag is set. 12/23/2004 Office Action at 26. The Office Action relied upon Reynolds as teaching the missing elements. However, as discussed above, Reynolds teaches setting a special flag to determine whether to enter a fail-safe mode. The special flag is clearly not used for causing the loading of a second routine to retrieve data to recover the system over a network. Thus, a *prima facie* case of obviousness cannot be established with respect to claim 28 because the hypothetical combination of Halladay, Dixon, and Reynolds does not teach or suggest all elements of the claim. Moreover, in view of the fact that there existed no motivation or suggestion to combine Halladay and Reynolds (see arguments with respect to claim 1), no motivation or suggestion existed to combine Halladay, Dixon, and Reynolds. Therefore, withdrawal of the obviousness rejection of claim 28 is respectfully requested.

Claim 29 has been cancelled to render the rejection of the claim moot.

Claim 33, which depends from claim 28, is allowable for at least the same reasons.

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Allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (MCT.0133US).

Respectfully submitted,

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Dan C. Hu
Registration No. 40,025
TROP, PRUNER & HU, P.C.
8554 Katy Freeway, Suite 100
Houston, TX 77024
Telephone: (713) 468-8880
Facsimile: (713) 468-8883